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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/618,794 07/18/00 CAWSE

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EXAMINER

PRASTHOFFER, T

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/618,794

Applicant(s)

CAWSE, JAMES NORMAN

Examiner

Thomas W Prasthofer

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1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Detailed Action

Status of the Application

Receipt is acknowledged of a response to an election of species requirement on May 14, 2001 (Paper No. 6).

Status of the Claims

Claims 1-25 are pending in the present application. Claims 1-15 have been withdrawn from further consideration by the examiner as being drawn to a non-elected invention. Claims 16-25 are being examined on their merits.

Response to Restriction and Election of Species with Traverse

Applicant's election of Invention II, claims 16-25 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims Rejections – 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

incomplete
1. Claims 16-25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: relationships between a vessel, charge port, discharge

port, and reaction chamber. For example, is the reaction chamber contained within the vessel? Are the ports in communication with the reaction chamber through the vessel or independent of the vessel?

2. Claims 16-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

W A. Claims 16 and 25 recite "a vessel having a charge port adapted to sequentially receive a plurality of discrete combinations of reactants." The term "adapted to" is not clear because there is no description of how the charge port is to be adapted. "Adapted to" in this case could be interpreted as broadly as having an opening or more specifically as having a motorized conveyor onto which a rack of tubes may be loaded. Adaptations may also include the ability to receive liquid or gaseous combinations of reactants. It is not possible to determine the metes and bounds of the claimed invention.

W B. Claims 16 and 25 recite "a reaction chamber in communication with said charge port adapted to receive and enclose a plurality of discrete combinations of reactants." It is not clear if the reaction chamber or the charge port is to be adapted "to receive and enclose a plurality of discrete combinations of reactants." The term "adapted to" is not clear because there is no description of what the adaptation encompasses. "Adapted to" in this case could be interpreted as broadly as having an opening or more specifically as having a motorized conveyor onto which a series of tubes may be loaded. Adaptations may also include the ability to receive liquid or gaseous combinations of reactants. It is not possible to determine the metes and bounds of the claimed invention.

W C. The term "sized to receive a plurality of vials" in claim 17 is a relative term which renders the claim indefinite. The term "sized to receive a plurality of vials" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Vials can be of any size and can be received in any number or configuration. The size of the reaction chamber is rendered indefinite.

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- W D. The term "reaction zone" as used in claim 20 is not definite because it is not clear what a reaction zone is.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 16 and 17 are rejected under 35 U.S.C. 102(b,e) as being anticipated by Cody et al. (1994) U.S. Patent No. 5,324,483.

The Cody et al. reference discloses an apparatus for the chemical synthesis of compounds (abstract). The apparatus comprises a manifold (vessel) with a plurality of ports adapted to serve as inlet and outlet ports for materials to be introduced into and recycled out of the manifold (charge and discharge ports) (column 9, lines 16-36). The apparatus comprises a reservoir rack (reaction chamber) in communication with the manifold ports via reaction tubes (column 8, lines 23-57). The reservoir rack is sized to receive a series of removable reaction wells (vials) which are disposed linearly (in rows). *manually remove tubes of product*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Thomas Prasthofer** at telephone number (703) 308-4548. The examiner can normally be reached on Monday-Friday, 8:00-4:30.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.

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6. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1235.

Thomas Prasthofer, Ph.D.

June 18, 2001

**BENNETT CELSA
PRIMARY EXAMINER**

Handwritten signature of Bennett Celsa, consisting of a stylized, cursive script.